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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/797,373	03/09/2004	Alain Leas	88265-74701	4476		
28765	7590	04/29/2008	EXAMINER			
WINSTON & STRAWN LLP PATENT DEPARTMENT 1700 K STREET, N.W. WASHINGTON, DC 20006				THAKUR, VIREN A		
ART UNIT		PAPER NUMBER				
1794						
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/797,373	LEAS ET AL.	
	Examiner	Art Unit	
	VIREN THAKUR	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 January 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4,8-10 and 25-37 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4,8-10 and 25-37 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Response to Amendment

1. The rejection of claims 1-4, 8-10 and 25-37 under 35 U.S.C. 112, second paragraph has been withdrawn as a result of the amendment to claim 1.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1-4,8,10 25-28, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krein (US 2106893) in view of Damato (EP 0276333) and**

Kuehl et al. (EP 0848910 A2) for the reasons given in the previous Office Action, mailed September 25, 2007.

5. Claims 9, 29 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krein (US 2106893) in view of Damato (EP 0276333) and Kuehl et al. (EP 0848910 A2) for the reasons given in the previous Office Action, mailed September 25, 2007, in view of Newsteder (US 4778683), Palmer (US 20030099746 A1), and Philips et al. (US 5035907).

Claims 9, 29, 34 and 36 differ from the combination of the Krein, Damato and Kuehl et al. in reciting the new limitation of the decorative pattern including writing, script, a logo or a symbol. Although Kuehl et al. teach that the design can include patterns or appearances such as marbled, mottled, hued, variegated, dappled, etc..., it is noted that Newsteder, Palmer and Philips et al. have been further relied on to teach that it has been conventional in the art to use another edible composition for the purpose of printing writing or symbols onto a confection. Therefore, although Krein modified by Damato and Kuehl et al. are silent in specifically reciting wherein the pattern includes writing, script, a logo or a symbol, the prior art teaches that it has been conventional to use symbols, logo or writing to impart a design onto a food product. It is further noted however, that since Kuehl et al. teach decorative patterns, that to specifically change that pattern into a particular shape, such as a logo or writing, would not have provided a patentable feature over the prior art since the art already teaches that it has been conventional to make patterns into the shell of a frozen confection.

Once it was known to provide a product with a pattern or design, to employ a pattern or design that conveys a message or symbol, i.e. a pattern or design in the form of writing or a logo, would have been an obvious matter of choice and/or design, especially since it was, of course, well established to impart writing or logos on products as evidenced by the prior art.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4, 8-10, 25-30, 32, 33 and new claims 34-36 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of copending Application No. 10/294764

in view of Kuehl et al. (EP 0848910 A2) and Damato (EP 276333), for the reasons cited in the prior Office Action, mailed January 29, 2007.

8. Claim 31 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3,6,16,17,20 of copending Application No. 10/294,764 in view of Kuehl et al. (EP 0848910 A2) and Damato (EP 276333), as applied to claims 1-4,8-10,25-30,32 and 33 above, further in view of Selbak (US 5425527), for the reasons cited in the prior Office Action, mailed January 29, 2007.

9. Claims 1-4, 8-10 and 25-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-9,19-27 of copending Application No. 10/385,177 in view of Kuehl et al. (EP 0848910 A2), for the reasons cited in the prior Office Action, mailed January 29, 2007.

10. Claims 1-4, 8-10,25-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5,10-14 of copending Application No. 10/800,222 in view of Kuehl et al. (EP 0848910 A2), for the reasons cited in the prior Office Action, mailed January 29, 2007.

11. Claims 32 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-5,10-14 of copending Application No. 10/800,222 in view of Kuehl et al. (US EP 0848910 A2) as

applied to claims 1-4,8-10 and 25-31 above, further in view of Damato (EP 276333), for the reasons cited in the prior Office Action, mailed January 29, 2007.

Response to Arguments

12. On page 8 of the response, Applicants assert that “Krein expressly states that an important consideration in choosing the material, from which the wrapper is made, is that the material be cheap, as the wrapper is to be discarded at the time the confection is eaten.” Applicants cite page 1, lines 34-38 of Krein, however this citation does not mention using cheap material, but rather, only states “the confection is encased in what may be termed a temporary wrapper...being of such economical material as to be destroyed and discarded at the at the time it is desired to eat the confection.” Therefore, applicant’s opinion that Krein teaches using “cheap” material is not supported by the reference. It is further noted that cheap and economical are not one in the same, since a material that is economical does not have to be cheap, and a material that is cheap is not necessarily economical.

13. On pages 8-9 of the response, Applicants assert that it is not possible for Damato’s ice confectionary to be in complete surface-to-surface contact with the internal surface of the packaging sheet, as Damato’s figures 2 and 3 show a space between the ice confection and packaging.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Krein already teaches a packaging sheet which is in contiguous contact with the shell within. D'Amato has been relied on to teach the conventionality of using transparent plastic for the purpose of forgoing the need for packaging that would have additional pictures or drawings for showing the consumer what the food contained therein looks like. Furthermore, it is noted that D'Amato further teaches solving the problem of viewing the contents within the package, by using a transparent packaging. If one did not want to use printed indicia, so as to make the packaging more economical, it would have been obvious to have used transparent packaging so that the consumer can directly view the product. It would further have been obvious to use transparent packaging, since Kuehl teaches producing a design onto a chocolate shell. Therefore instead of using a printed picture of the design on the packaging, the transparent packaging of Damato would have allowed the consumer to directly view the design.

14. On page 9 of the response, Applicants assert that Krein was focused primarily on minimizing costs when creating his wrapper thus was not concerned with the

consumer's ability to view the confection prior to removal of the wrapper, because if he were, he would have chosen to use a wrapper that was transparent, or translucent.

Applicant's further assert that Krein's mere recognition of the attractiveness of a two-toned effect of combining chocolate and ice cream does not constitute motivation for combination with Cummings to result in the present invention.

This argument as been carefully considered but is not deemed persuasive.

Regarding minimizing costs, it is noted that Krein teaches that the material would be economical, not inexpensive. As discussed above, being economical and being inexpensive are not one in the same. Regarding Krein's motivation, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is noted that as the package is being removed, that one would have seen a two tone color effect that would have been highly attractive. In any case, D'amato has been relied on to teach the conventionality of using a transparent plastic wrapping for a frozen confection for the purpose of viewing the contents therein, instead of relying on indicia printed on an opaque wrapper.

15. On page 10 of the response, Applicants assert that there is no motivation to combine Krein and Damato to provide the combined chocolate cone and packaging of

the present invention and there is further no motivation to combine Krein and Damato since the two references teach away from each other.

This argument has been considered but is not deemed persuasive. The examiner respectfully notes that Krein is concerned with the appearance of the ice cream since he teaches that as the wrapping is removed the consumer would see a two-tone and highly attractive color effect (page 1, right hand column, lines 46-53). It is noted that Krein teaches a tight fitting wrapping, but as discussed in the previous Office Action, is silent in teaching a plastic transparent wrapping. D'Amato has been relied on to teach the conventionality of plastic wrapping, as discussed above for the purpose of directly viewing the contents within the packaging, as opposed to having to rely on indica or printed images. Therefore D'Amato teaches that it has been conventional in the art to use a transparent wrapping for the purpose of viewing the contents within a package.

16. On page 11 of the response, Applicants assert that there is no disclosure or suggestion in Kuehl that his chocolate or water based coating material is even capable of being formulated into a self-supporting shell. This argument has been carefully considered but is not deemed persuasive. It is noted that both Applicants and Kuehl disclose a shell and a frozen confection within said shell. Applicants have not claimed a self supporting shell. Even further, it is unclear as to how self supporting a chocolate shell used to hold ice cream can be without the shell being cumbersome for a consumer to bite into. Additionally, it is noted that on page 3, lines 17-19, Kuehl teaches that a

stick may be added to the ice cream with the chocolate shell. To the ordinary skilled artisan, it would have been obvious that the exclusion of a stick would require the shell to have some strength such that when a consumer grips the product that the shell does not break.

17. Further on page 11, Applicants assert that there is no need for a sleeve material of any time in the process of Kuehl and further assert that Kuehl does not teach the use of or need for a transparent or other packaging sleeve during initial manufacture of the ice confection. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kuehl has been relied on to teach the conventionality of a secondary chocolate based confection used for providing a decorative pattern into a chocolate based shell which holds a frozen confection, such as ice cream. Damato has been relied on to teach the conventionality of using transparent packaging for the purpose of directly viewing the contents within the packaging. Krein teaches complete surface to surface contact between a chocolate shell and the frozen confection packaging.

18. Applicants' arguments on page 10 with respect to the presence of writing or a logo on the shell and applicants arguments on page 11 with respect to Kuehl failing to disclose any advantages in providing writing or a logo by his process have been considered but are not persuasive. Applicants are directed to the rejection in paragraph 5 above. Even further, it is noted that Kuehl already teaches applying a pattern or design into the chocolate shell, using a second chocolate composition. By using transparent packaging to display the designs taught by Kuehl, one would, in essence, be using the actual design on the chocolate shell (as opposed to printed packaging) to market and thus advertise the product. To make a specific logo or symbol would not have provided a patentable feature over the prior art, since the art teaches that it has been conventional to use a second edible composition for the purpose of writing or designing symbols into a first food product.

19. As a result of the cancellation of claims 1-14 of copending application 10984914, the double patenting rejections over claims 1-3 and 7-14 of copending application 10984914 have been withdrawn.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. T./
Examiner, Art Unit 1794

/Steve Weinstein/
Primary Examiner, Art Unit 1794